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Docket No. F-7051

Ser. No. 09/935,222

REMARKS

Claims 1-4 remain pending in this application. Claims 1-4 and 13-16 are rejected. Claims 13-16 are cancelled herein. Claims 5-12 and 17-24 are previously cancelled herein. Claim 1 is amended herein to clarify the invention by incorporating the subject matter of claim 13 previously dependent from claim 1. Accordingly, the amendment does not raise any new issues since the subject matter was previously considered as claim 13. Hence, the amendment merely removes issues and entry thereof is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-4 are now rejected under 35 U.S.C. §103(a) as obvious over the Mozer, Bain, Xin, and Scott references. Claims 13-16 are rejected based on the aforesaid references and additionally the Setlak reference. The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

In the last response filed June 26, 2006, it was again made clear that the prior art failed to disclose the call button or message button being conductive to discharge the static electricity. In response to this filing the Examiner has now revised his

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collection of applied references to exclude the von Bauer reference which did not disclose the handheld control and display indoor module, and include the Xin reference to remedy this deficiency. However, the Examiner did not address the glaring deficiency regarding the lack of any teaching of or suggestion to provide a conductive call button. Thus, yet again, the rejection in the Office Action does not properly set forth a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection". It is respectfully submitted that there is no showing of the element of a conductive call button in an outdoor unit of a wireless call system. Indeed, there is no showing of such a conductive button for effecting any type of system operation at all. Additionally, the applied art lacks any suggestion to arrive at the conductive call button.

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According to the present invention of claim 1, a call button is made of conductive material that is conductive resin or the like and grounded to effect static discharge. Namely, the present invention of claim 1 utilizes a call button as a static discharge part thereby requiring a visitor to effect static discharge without unconscious effort, and simultaneously form the call button from conductive resin or the like that is grounded to result inexpensiveness of the wireless call system. Namely, the present invention of claim 1 does not merely use conductive material and have a connection connected to ground, but has significance in that the call button is made of conductive resin or the like and grounded.

With regard to the conductive call button, the Examiner first states without prior art support that it would be obvious to use conductive material to provide a ground connection to prevent damaging "circuitry within the access control unit." The Examiner cites the Scott reference for teaching a fingerprint input device used to control access. Yet nothing in the Scott reference suggests such circuitry is susceptible to static damage. In this regard there is no suggestion to provide any method for discharge provided by the Scott art, much less a discharge avenue provided in a call button as claimed.

The Examiner has cited the Bain reference for teaching a message input button. The Bain disclosure is silent on any alternative functioning of the message input button besides the activation of the equipment to receive a message. Thus, there is no suggestion that a button may be made conductive to effect *both* an active

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equipment operation function such as recording a message or making a call *and* a discharging function. This dual functionality of the claimed call button is not hinted at by either the Bain or the Scott references nor any of the other applied references.

In making the present rejection the Examiner relies on the combination of four different references, the Mozer, Bain, Xin, and Scott references, each remedying deficiencies of the others in a patchwork quilt of reference. Yet none of these reference addressed static discharge.

Claims 13-16 address the composition of the call button and the Examiner cites the Setlak reference to yet further remedy the deficiencies of the aforesaid references for its discussion of a discharge area in order to patch the hole of the other references having a dearth of disclosure concerning static discharge. It is well settled that features of prior art references may not be assembled to establish obviousness using the pending claims as a template. Indeed, the court in *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) stated the following:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” (quoting *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). . . . The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the

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modification obvious unless the prior art suggested the desirability of the modification.

Thus, the prior art reference must suggest some desirable attribute for making the proposed combination and not just provide an alternative.

The Examiner merely cites the Setlak reference for teaching conductive material. The rejection is deficient in two respects. It is first noted that the Setlak reference teaches a discrete separate area 54 whose sole purpose is for discharge is used to discharge the user. The area 54 *is not a button* to be pressed for accomplishing a function other than discharge. In the Setlak reference the unit 71 is the fingerprint input device and is separate from the discharge area electrode 54. As such, the claimed dual functioning element of the call button of claim 1, that is, a call function which is integrated with a static discharge function by virtue of being conductive and grounded, is not taught by the Setlak reference.

Second, there is no motivation or suggestion to arrive at the dual function element claimed in claim 1. Neither Setlak nor any of the other references indicate that a discharge area may have another function besides discharge. Still further, there is no suggestion that a button that is used for grounding be also a button for calling or leaving a message which is a necessary button for a caller to use. In view of the lack of guidance of the prior art applied, little can be imagined but that the presented assemblage of five different reference is no more than a listing prior art references

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cobbled together using the pending claims as a template. Indeed, the Examiner cherry picks from each reference and concludes:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use conductive material and have a connection connected to ground in order to get rid of static discharge when a user touches the access control unit.

September 29, Office Action, page 6. The above statement is not based on any of the first four cited references which the Examiner was applying at this point in the reference. As noted, the Setlak reference teaches a discharge area and this reference was only applied in the rejection of claim 13, subject matter of which is now incorporated into claim 1. However, neither the Examiner's statement nor the Setlak reference suggests incorporating the discharging into a button, and still further, there is no hint to incorporate it into the call button.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference(s) for the reasons stated above. Reconsideration of the rejections of claims 1-4 and their allowance are respectfully requested.

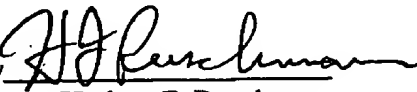
No fees are believed due. If there are any fees due the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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